

REMARKS/ARGUMENTS

The Applicant originally submitted Claims 1-20 in the application. In a the present response, the Applicant amended independent Claims 1, 8, and 15 to include the limitations from dependent Claims 5, 12, and 19 and canceled without prejudice or disclaimer dependent Claims 5, 12, and 19. No other claims have been added. Accordingly, Claims 1-4, 6-11, 13-18, and 20 are currently pending in the application.

I. Rejection of Claims 1-2, 4-5, 8-9, 11-12, 15-16, and 18-19 under 35 U.S.C. §103

The Examiner has rejected Claims 1-2, 4-5, 8-9, 11-12, 15-16, and 18-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,381,721 to Warren in view of U.S. Patent No. 7,058,856 to Shinmori. The Applicant believes the invention as presently claimed, however, is neither shown nor suggested in the cited combination of Warren and Shinmori. More specifically, the Applicant fails to find where the cited combination teaches or suggests port inhibit circuitry that determines an extent to which a testing port is enabled, wherein the extent is selected from the group consisting of: fully enabled, only partially disabled, and completely disabled as now recited in amended independent Claims 1, 8, and 15.

The Examiner recognizes Warren doesn't disclose inhibit circuitry is modifiable to achieve a configuration that determines an extent to which the testing port is enabled and cites Shinmori to cure this deficiency. (See Final Rejection, page 2.) Additionally, the Examiner asserts that column 8, lines 20-50 and lines 32-60 of Shinmori teaches the extent is selected from the group consisting of: fully enabled, only partially disabled, and completely disabled. (See Final Rejection, page 5.) Shinmori teaches a technique to release a security bit which has been set once. "Only the person

who knows the contents of memory having the following address after the randomly chosen one in the flash ROM 18 can release the security bit.” (See column 8, lines 15-16 and lines 60-62.) Thus, Shinmori teaches the security bit can either be fully enabled or completely disabled. The Applicant fails to find where Shinmori teaches or suggests port inhibit circuitry that determines an extent to which a testing port is enabled, wherein the extent is only partially disabled as now recited in amended independent Claims 1, 8, and 15.

As such, the cited combination of Warren and Shinmori does not establish a *prima facie* case of obviousness of amended independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 1-2, 4-5, 8-9, 11-12, 15-16, and 18-19 and allow issuance thereof.

II. Rejection of Claims 6 and 13 under 35 U.S.C. §103

The Examiner has rejected Claims 3, 10 and 17 under 35 U.S.C. §103(a) as being unpatentable over Warren in view of Shinmori and further in view of the U.S. Patent No. 7,124,340 to Bos, *et al.* The Applicant respectfully disagrees.

As established above, the cited combination of Warren and Shinmori does not provide a *prima facie* case of obviousness of now amended independent Claims 1 and 8. Bos has not been cited to cure the deficiency of the cited combination but to teach wherein the testing port comprises a direct loopback between input and output pins thereof. (See Final Rejection, page 6.) Additionally, the Applicant does not find where Bos cures the above-noted deficiencies of the cited combination of Warren and Shinmori. As such, the cited combination of Warren, Shinmori, and Bos does not establish a *prima facie* case of obviousness of now amended independent Claims 1 and 8 and Claims

that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 6 and 13 and allow issuance thereof.

III. Rejection of Claims 3, 10 and 17 under 35 U.S.C. §103

The Examiner has rejected Claims 3, 10 and 17 under 35 U.S.C. §103(a) as being unpatentable over Warren in view of Shinmori and further in view of U.S. Patent No. 6,769,081 to Parulkar. The Applicant respectfully disagrees.

As established above, the cited combination of Warren and Shinmori does not provide a *prima facie* case of obviousness of now amended independent Claims 1, 8, and 15. Parulkar has not been cited to cure the deficiency of the cited combination but to teach bits in a one-time programmable register. (See Final Rejection, page 6.) Additionally, the Applicant does not find where Parulkar cures the above-noted deficiencies of the cited combination of Warren and Shinmori.

As such, the cited combination of Warren, Shinmori, and Parulkar does not establish a *prima facie* case of obviousness of now amended independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 3, 10, and 17 and allow issuance thereof.

IV. Rejection of Claims 7, 14 and 20 under 35 U.S.C. §103

The Examiner has rejected Claims 7, 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Warren in view of Shinmori and further in view of U.S. Patent No. 6,522,100 to Hansford. The Applicant respectfully disagrees.

As established above, the cited combination of Warren and Shinmori does not provide a *prima facie* case of obviousness of now amended independent Claims 1, 8, and 15. Hansford has not been cited to cure the deficiency of the cited combination but to teach the subject matter of the above-mentioned dependent claims. (See Final Rejection, page 7.) Additionally, the Applicant does not find where Hansford cures the above-noted deficiencies of the cited combination of Warren and Shinmori. As such, the cited combination of Warren, Shinmori, and Hansford does not establish a *prima facie* case of obviousness of now amended independent Claims 1, 8, and 15 and Claims that depend thereon. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §103(a) rejection of Claims 7, 14, and 20 and allow issuance thereof.


V. Conclusion

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-4, 6-11, 13-18, and 20.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

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